

Supplemental Response to Argument

(11) Response to Argument

A. Claims 11-19, 21 and 23-24 are rejected under 35 USC 103(a) as being unpatentable over Smith et al (U.S. Pat. 5,238,587).

On pages 2-3 of the Supplemental Appeal Brief, the appellant argues that the claims are unobvious over the patent to Smith. Claim 11 contains no structure but merely calls for a kit with list of elements “in absence of a bag” which has no relationship with respect to other elements listed. Since the appellant claims a kit, then, the appellant must positively claim the invention. Here the appellant merely claims and relies upon an absence of an element, e.g. bag, in a kit for patentability. The examiner is uncertain what the relationship is between the absence or presence of the bag and the kit. A kit must contain a number of positive items not an absence of items. Here, it appears to be the appellant’s intention to rely upon the negative limitation “in absence of a bag” for patentability. The examiner cannot agree with the appellant for patentability of a kit with an absence of an element.

On page 3 of the Supplemental Appeal Brief, the appellant argues that the broadly claimed invention retains the dry cleaning/refreshment function even though the bag is eliminated from the kit and/or system and/or method. The examiner disagrees. The prior art references also retain the dry cleaning/refreshment function even though the bag with its “containing” function is eliminated same as the broad claims at issue. There is absolutely no structural difference between the prior art reference and the broad claims at issue. Moreover,

regarding this claim limitation “in the absence of bag”, it is well settled that to eliminate an element and its function is deemed to be obvious if the function of the element is not desired. The function of the bag is to contain the liquid cleaning/refreshment composition. In this case, it is the containment function of the bag is being eliminated. Therefore, it is the examiner’s position that to omit the bag and its containment function is an obvious expedient because the remaining elements perform the same functions as before. The elimination of the bag and its containment function is also deemed to be an obvious matter where the function attributed to such bag is not desired or required. This rejection is consistent with MPEP 2144.04 II and other legal precedents, Ex parte Wu, 10 USPQ 2031; In re Larson, 340 F 2d 965, 144 USPQ 347 (CCPA 1965) and In re Kuhle, 526 F 2d. 553, 188 USPQ 7 (CCPA 1975).

B. Claims 11-19 and 23-24 are rejected under 35 USC 103(a) as being unpatentable over Weller et al (U.S. Pat. 5,876,462).

On pages 4-5 of the Supplemental Appeal Brief, the appellant argues that the claims are unobvious over the patent to Weller et al. Claim 11 contains no structure but merely calls for a kit with list of elements “in absence of a bag” which has no relationship with respect other elements listed.. Since the appellant claims a kit, then, the appellant must positively claim the invention. Here the appellant merely claims and relies upon an absence of an element, e.g. bag, in a kit for patentability. The examiner is uncertain what the relationship is between the absence or presence of the bag and the kit. A kit must contain a number of positive items not an absence of items. Here, it appears to be the appellant’s intention to rely upon the negative limitation “in absence of a bag” for patentability. The examiner cannot agree with the appellant for patentability of a kit with an absence of an element. In the last two paragraphs of page 4 of the

Supplemental Appeal Brief, the appellant argues that the broadly claimed invention retains the dry cleaning/refreshment function even though the bag is eliminated from the kit and/or system and/or method. The examiner disagrees. The prior art references also retain the dry cleaning/refreshment function even though the bag with its “containing” function is eliminated same as the broad claims at issue. There is absolutely no structural difference between the prior art reference and the broad claims at issue. Moreover, regarding this claim limitation “in the absence of bag”, it is well settled that to eliminate an element and its function is deemed to be obvious if the function of the element is not desired. The function of the bag is to contain the liquid cleaning/refreshment composition. In this case, it is the containment function of the bag is being eliminated. Therefore, it is the examiner’s position that to omit the bag and its containment function is an obvious expedient because the remaining elements perform the same functions as before. The elimination of the bag and its containment function is also deemed to be an obvious matter where the function attributed to such bag is not desired or required. This rejection is consistent with MPEP 2144.04 II and other legal precedents, Ex parte Wu, 10 USPQ 2031; In re Larson, 340 F 2d 965, 144 USPQ 347 (CCPA 1965) and In re Kuhle, 526 F 2d. 553, 188 USPQ 7 (CCPA 1975). On top of page 5 of the Supplemental Appeal Brief, the appellant also argues that there were additional benefits of removing wrinkles which the prior art references failed to teach. It should be noted that the wrinkle removals are nowhere to be found in the claims except in the preamble of claim 17. This line of arguments is not germane to the claims at issue. Moreover, the claimed cleaning/refreshment composition in the prior art is same as claimed. Therefore, it is inherent that the additional benefit of removing wrinkles would be accomplished by the prior art references with the same chemicals as claimed.

C. Claims 20-22 are rejected under 35 USC 103 as unpatentable over Smith (U.S. Pat. 5,238,587) in view of You (U.S. Pat. 5,789,368).

On page 5 of the Supplemental Appeal Brief, the appellant argues that the You patent does not address the deficiencies of Smith without stating any specific reasons. Therefore, the examiner considers the appellant conceded to this rejection due to lack of arguments.

D. Claims 20-22 are rejected under 35 USC 103(a) as unpatentable over Weller (U.S. Pat. 5,876,462) in view of You (U.S. Pat. 5,789,368).

On page 5 of the Supplemental Appeal Brief, the appellant argues that the You patent does not address the deficiencies of Smith without stating any specific reasons. Therefore, the examiner considers the appellant conceded to this rejection due to lack of arguments.

E. Claim 25 is rejected under 35 USC 103(a) as unpatentable over Smith (U.S. Pat. 5,238,587) or Weller et al (U.S. Pat. 5,876,462).

On page 5 of the Supplemental Appeal Brief, the appellant argues that the rejection does not address the limitations, specially the elimination of the bag. Therefore, appellant believes the claim 25 is unobvious. The examiner disagrees. Both Smith and Weller patents show everything as claimed except the negative limitation "absence of bag". It is the examiner's position that, it is well settled that to eliminate an element and its function is deemed to be obvious if the function of the element is not desired. The function of the bag is to contain the liquid cleaning/refreshment composition. In this case, it is the containment function of the bag is being eliminated. Therefore, to omit the bag and its containment function is an obvious expedient because the remaining elements perform the same functions as before. The elimination of the bag and its containment function is also deemed to be an obvious matter where the function

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attributed to such bag is not desired or required. This rejection is consistent with MPEP 2144.04

II and other legal precedents, Ex parte Wu, 10 USPQ 2031; In re Larson, 340 F 2d 965, 144

USPQ 347 (CCPA 1965) and In re Kuhle, 526 F 2d. 553, 188 USPQ 7 (CCPA 1975).

For the above reasons, it is believed that the rejections should be sustained.

TC director has approved Supplemental Response to Argument by signing below:

/KAREN M. YOUNG/
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